

GP 3312

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MARCH 6, 1998  
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ROBERT A. FRANKS

Robert A. Franks Mar. 6, 1998

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4-3-98  
#16

PATENT  
CASE PD0340K

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Thomas J. Ambrosio, Charles R. Ashley, Alan J. Bilanen, Charles M. Huck,  
Andrew E. Kaufman, David J. Kenyon, Srinivas Manthena, Henry R. Sochon,  
Ken Wilkinson and Tsong-Toh Yang

Serial No.: 08/446,804

Examiner: V. Srivastava

Filed: June 1, 1995

Group Art Unit: 3312

Title: INHALER FOR POWDERED MEDICATIONS

MAILED

Assistant Commissioner for Patents  
Washington, D.C. 20231

MAR 17 1998

GROUP 3300

Sir:

REQUEST FOR RECONSIDERATION

In response to the Office Action mailed on December 15, 1997 for the  
subject application, the applicants hereby request reconsideration of the rejection  
for obviousness-type double patenting, and the objection to the abstract, in view of  
the following discussion.

Claims 1-6, 8-27 and 56 remain pending in this application, with all of said  
claims standing rejected for double patenting over U.S. Patent 5,687,710 which  
was granted from a divisional application from the present application. The  
rejection is based upon the claimed subject matter being "fully disclosed in the  
patent."

Pl. with Abstract.

In a telephonic interview on December 2, 1997, Examiner Srivastava and the undersigned discussed obviousness-type double patenting rejections, but were not able to agree on certain fundamental issues. It remains the applicants' position that a double patenting rejection cannot properly be based upon a disclosure of subject matter in a patent or allowed application, but must be based on a comparison of only claimed subject matter.

A thorough discussion of double patenting can be found at M.P.E.P. § 804, where the following statement appears (see attached page 800-10):

Since the doctrine of double patenting seeks to avoid unjustly extending patent rights at the expense of the public, the focus of any double patenting analysis necessarily is on the claims in the multiple patents or patent applications involved in the analysis.

It is logical to restrict the analysis to only the claims, since "patent rights" never flow from the scope of a patent specification, but are defined solely by the scope of the appended claims which survive an examination process. Turning to the mechanics of formulating an obviousness-type double patenting rejection, the above-cited section continues as follows (see attached page 800-18):

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in a claim of a patent, the disclosure of the patent may not be used as prior art.

Also found on page 800-18 is the statement:

If ... both are filed on the same day, only a one-way determination of obviousness is needed in resolving the issue of double patenting - i.e., whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim of the patent.

Applying these principles, it is immediately apparent that the rejection of the applicants' claims was not proper. From the language of the rejection, it is abundantly clear that the pending claims were rejected as being obvious in view of the cited patent specification, not in view of the patent claims which are totally unrelated in scope to the claims of the present application. The rejected claims pertain to a powder inhaler having specific features, while the patent claims are directed to a nozzle. It is totally irrelevant that the patent was a voluntary divisional of the present application, and therefore contains an identical disclosure. There is

no possibility that the patent claims can render the application claims obvious, and this rejection should be withdrawn.

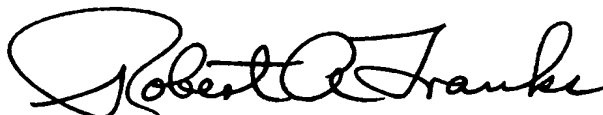
The decision of *In re Schneller*, 158 USPQ 210 (CCPA 1968), cited in the Office Action, is not contrary to the position of the applicants. The *Schneller* application had a disclosure which was also present in the disclosure of the patent, but double patenting was found, based on the relationship of the respective claims: it was considered obvious to claim the combination of elements ABCY, when the patent claimed the combination ABCX but disclosed combinations containing Y. It is stated at 214 that "... appellant has the burden of establishing that the invention claimed in his patent is 'independent and distinct' from the invention of the appealed claims." *Schneller* differs from the present situation, in that the application from which the patent was granted was not filed simultaneously with the other application. It further differs by the close relationship of the two sets of claims, so this decision cannot support the rejection of the applicants' claims.

It is not clear from the record whether the Examiner has been aware of the currently pending application which is also a divisional of the presently examined application: Serial No. 08/460,604 filed June 1, 1995 (Charles R. Ashley et al.) which now stands allowed by Art Unit 3312. The claims of the divisional application are directed to a counter for a powdered medication inhaler.

The abstract provided with the applicants' response filed August 20, 1997 has been objected to, as having more than one paragraph. Even though the abstract did consist of only one paragraph (and actually consisted of only a single sentence), the applicants hereby submit a replacement abstract having no indentations to demarcate specific features.

It is believed that all issues of patentability have been resolved, and that allowance of the pending claims in the application is now in order. However, if further minor matters remain to be resolved for disposition of this application, please call the undersigned to arrange for a telephonic or personal interview.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Franks". The signature is fluid and cursive, with the first name "Robert" being more prominent than the last name "Franks".

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